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**CERTIFICATE OF MAILING PURSUANT TO 37 C.F.R. § 1.8**

Pursuant to 37 C.F.R. § 1.8, I hereby certify that this Supplemental Declaration in Support of Petition to Accept Application Due To Inventor Refusing to Sign, is being deposited with the United States Postal Service, as first class mail in an envelope addressed to: Mail Stop: Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22323-1450, on:

Date: February 27, 2004

By   
Beverly Fletcher

**IN THE UNITED STATES PATENT AND PATENT  
TRADEMARK OFFICE**

**PATENT**

Applicant(s): **Berardi, et al.**

Docket No.: **60655.0100**

Serial No.: **10/611,563**

Group Art Unit: **TBA**

Filed: **June 30, 2003**

Examiner: **NYA**

TITLE: **CLEAR CONTACTLESS CARD**

**PETITION FOR ACCEPTANCE OF APPLICATION PURSUANT TO 37 C.F.R. §1.47  
INVENTOR REFUSES TO SIGN**

**Supplemental Declaration and Inadvertent Omission**

Commissioner for Patents  
Box: **Petition/Missing Parts**  
P.O. Box 1450,  
Alexandria, VA 22323-1450

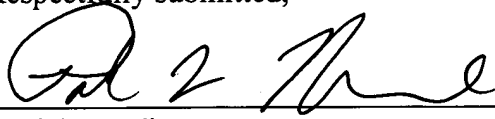
Dear Sir:

Applicants ("Petitioners") submit the attached Supplemental Statement of Facts in Support of the Petition to Accept the Application due to Inventor Refusing to Sign, which was filed on February 26, 2004. Additionally, Petitioners submit herewith "Exhibit D", which Petitioners inadvertently left out of their February 26, 2004 Petition. Petitioners respectfully request that the Supplemental Statement of Facts and Exhibit D be considered along with the previously submitted Petition.

The Petitioners respectfully request favorable consideration of their February 26, 2004 Petition Pursuant to 37 C.F.R. §1.47(a), and acceptance of the declarations of the signing inventor submitted therewith. Should the Examiner wish to discuss any of the above in greater detail, then the Examiner is invited to telephone the undersigned at the Examiner's convenience.

Date: 2/27/04

Respectfully submitted,

By   
Patrick L. Mixon  
Reg. No. 47,801

**SNELL & WILMER** L.L.P.  
One Arizona Center  
400 East Van Buren  
Phoenix, AZ 85004-2202  
Phone: (602) 382-6274



3. American Express retained Snell & Wilmer to prepare several applications related to radio frequency identification technology, including U.S. application no. 10/192,488, entitled SYSTEM AND METHOD FOR PAYMENT USING RADIO FREQUENCY IDENTIFICATION IN CONTACT AND CONTACTLESS TRANSACTIONS filed July 9, 2002, and U.S. provisional application no. 60/304,216 entitled SYSTEM AND METHOD FOR RFID PAYMENTS filed July 10, 2001, to which the 10/192,488 application claims priority. Additionally, American Express retained Snell & Wilmer to Prepare U.S. application no. 10/340,352 entitled SYSTEM AND METHOD FOR INCENTING PAYMENT USING RADIO FREQUENCY IDENTIFICATION IN CONTACT AND CONTACTLESS TRANSACTIONS filed January 10, 2003, and U.S. application no. 10/318,480 entitled SYSTEM AND METHOD FOR ASSIGNING A FUNDING SOURCE FOR A RADIO FREQUENCY IDENTIFICATION DEVICE filed December 13, 2002, which claims priority to the 60/304,216 provisional application, the 10/192,488 application and to the 10/340,352 application.

4. While preparing the 60/304,216 provisional application, the 10/192,488 application, the 10/340,352 application and the 10/318,480 application, Snell & Wilmer and American Express determined that Ms. Alexandra Mayers contributed to the inventions in the subsequently filed provisional and utility applications (See for example, Exhibit A). Thus, Ms. Mayers is listed as an inventor on all the noted applications.

5. In accordance with the Snell & Wilmer client matter docketing system, U.S. provisional application no. 60/304,216 is given attorney docket no. 40655.7050, U.S. application no. 10/192,488 is given attorney docket number 40655.7000, U.S. application no. 10/318,480 is given attorney docket no. 50655.0800, and U.S. application no. 10/340,352 is given attorney docket no. 40655.9400. In addition, the sequence of applications, which relate to the radio

frequency identification technology noted in paragraph 3, are referred to interchangeably in the attached Exhibits, as relating to the internal corporate names of PayFob, Pay Fob, and/or Roadrunner applications. These attorney docket numbers and application nomenclatures are referenced in communications between American Express, Snell & Wilmer and the inventors of the above noted applications (See for example, Exhibits A and B).

6. Ms. Mayers participated in the preparation of U.S. provisional application no. 60/304,216 (attorney docket no. 40655.7050), to which the 10/192,488 application (attorney docket no. 40655.7000) claims priority. On November 1, 2001, Ms. Mayers executed an assignment of the 60/304,216 provisional application to American Express (See Exhibit C). The assignment of the 60/304,216 application is recorded in the United States Patent and Trademark Office on January 7, 2002 at Reel No. 012442, Frame 0659, as shown in attached Exhibit D.

7. As indicated in the assignment document of the 60/304,216 provisional application, Ms. Mayers has assigned and transferred to American Express, the full and exclusive right to the invention described in the 60/304,216 provisional application (See Exhibit C, paragraph 4). In addition, Ms. Mayers's assignment of rights includes the assignment of the full and exclusive right to, *inter alia*, any provisional, nonprovisional, continuation, continuation in part, divisional or other patent application which claims priority to the 60/304,216 provisional application. As such, since the 10/192,488 application claims priority to the 60/304,216 provisional application, Ms. Mayers has assigned all full and exclusive rights to at least the 10/192,488 application to American Express.

8. In accordance with paragraph 5 of the assignment document, Ms. Mayers transferred to American Express, without further remuneration, a full and exclusive right to any improvements, derivatives works and applications based on, growing out of, or relating to the

60/304,216 application, and to provide reasonable assistance and execute any papers, if accurate, to preserve, acquire and/or perfect American Express's full protection and title in and to the 60/304,216 application and any improvements and to file any applications as noted in the assignment paragraph 3 (See Exhibit C, paragraph 5).

9. Application no. 10/611,563, to which this petition pertains, is a continuation in part of application no. 10/192,488, which claims priority to the 60/304,216 provisional application. Thus, the 10/611,563 application is an application based on, grows out of, and/or relates to the 60/304,216 application, such that Ms. Mayers has assigned to American Express full and exclusive right to the 10/611,563 application, in accordance with paragraph 5 of the assignment document.

10. In addition to the rights assigned to American Express under assignment document Exhibit C, American Express likely has rights in the invention of the 10/611,253 application since Ms. Mayers conceived of, and developed the invention, while employed by American Express. Ms. Mayers was a full-time, salaried employee of American Express during the time that the inventions were conceived (See Exhibit E), and that the inventions were conceived in line with the scope of Ms. Mayers's employment. As such, based on the facts set forth herein, it is my belief that a court of proper jurisdiction would award title of the invention to American Express, even though Ms. Mayers was no longer an employee of American Express when the applications were filed.

11. Consequently, based on the facts presented in paragraphs 6-9 (by Assignment) and paragraph 10 (by Judicial Award of Assignment), American Express has a substantial interest in the filing and prosecution of all applications noted above.

12. Application no. 10/611,563, the application to which this petition pertains, also claims priority to U.S. Application No. 10/062,106, entitled "TRANSACTION CARD," filed January 31, 2001, to U.S. Patent Application No. 10/092,681, entitled "TRANSACTION CARD," filed March 7, 2002, to U.S. Patent Application No. 10/288,945, entitled "PERFORATED TRANSACTION CARD," filed November 6, 2002, to U.S. Application No. 10/302,658, entitled "TRANSACTION CARD WITH DUAL CHIPS," filed November 22, 2002, to U.S. Patent No. 10/394,914, entitled "TRANSACTION CARD," filed March 21, 2003, and to U.S. Provisional Patent Application No. 60/427,977, filed on November 20, 2002. However, Ms. Mayers is not an inventor on those applications.

13. Notably, subsequent to the filing of the 60/304,216 application, Ms. Mayers left American Express's employment and refused to join in the prosecution of the 10/192,488 application, the 10/340, 352 application, and the 10/318,480 application. Thus, American Express through its attorneys at Snell & Wilmer, filed petitions for each of the applications under 37 C.F.R. §1.47(a), requesting acceptance of the applications since Ms. Mayers refused to join in the prosecution of the applications with the signing inventors. Exhibits G-O demonstrate Ms. Mayers refusal to join in the prosecution of those applications.

14. As indicated in the correspondence shown in Exhibits I, K, L, N and O, I contacted Ms. Mayers on numerous occasions for the purpose of encouraging her to execute the inventors' declarations and assignments for the priority applications (e.g., 40655.7000 and 40655.9450) to the 10/318,480 application. By October 17, 2002 neither American Express nor Snell & Wilmer received an executed declaration from Ms. Mayers (See Exhibit G). Other inquiries on October 24 and 25, 2003 revealed that all inventors had signed and returned the declaration except Ms. Mayers (See Exhibit H).

15. As shown in Exhibit J, on October 28, 2002, Ms. Mayers responded that she had been advised to examine her original employment agreements before executing an assignment of rights pertaining to the 10/192,488 application and the 60/396,577 provisional application. In response, I emailed Ms. Mayers to reiterate the need for Ms. Mayers to execute the declaration document (See Exhibit K). On January 15, 2003, because American Express had not received a response to its October 28, 2003 email, I again requested via email that Ms. Mayers execute the declaration and assignment documents (See Exhibit L).

16. Finally, in her January 15, 2003 response (See Exhibit M), Ms. Mayers indicated that she had spoken with an attorney, who noted that under the language of the employment documents, Ms. Mayers would be assigning her "rights" for consideration. Consequently, Ms. Mayers informed me that since she had not received any consideration, she does not believe she should execute the assignment and declaration documents pertaining to the 60/396,577 and the 10/192,488 applications.

17. As noted, because of Ms. Mayers demonstrated refusal to execute the inventor's declaration pertaining to the 10/192,488 application, the 10/318,480 application and the 10/340,352 application, to which the 10/611,563 claims priority, American Express and Snell & Wilmer filed separate Petitions to Accept each application pursuant to 37 C.F.R. §1.47(a). As of the signing of this Statement, the U.S. Office of Petitions had GRANTED all three petitions. (See Exhibits P, Q, R) However, since Ms. Mayers is an inventor on the 10/611,563 application, to which this Statement pertains, and she has also refused to sign the declarations and join in the prosecution of the 10/192,488 parent application, American Express is compelled to file the present Petition to avoid irreparable damage due to the potential loss of filing date of the present 10/318,480 application.

18. With respect to the declaration in the present 10/611,563 application, on January 28, 2004, I again forwarded to Ms. Mayers the 10/611,563 application and declarations for execution. (See Exhibit S). To date, we have not received a response regarding Ms. Mayer's willingness to execute the declaration. As was noted, Ms. Mayers informed American Express that her attorney advised her against signing the documents.

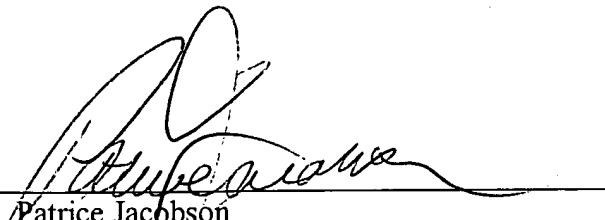
19. It should be noted although neither American Express nor Snell & Wilmer have received any response from Ms. Mayers regarding her intention to execute the 10/611,563 application declaration, Ms. Mayers did expressly indicate that she would not sign the declaration in the subsequent 10/340,352 application, which is one of several applications to which the 10/611,563 application claims. (See Exhibit O).

20. The deadline for responding to the "Notice to File Missing Parts" in the present 10/611,563 application expired November 27, 2003. To preserve American Express's rights in the invention, we are filing the present Petition for acceptance of the application in view of Ms. Mayers refusal to join with the remaining signing inventors.

21. Based upon the statements from Ms. Mayers in the attached email correspondence, and the fact that Ms. Mayers refuses to respond to my communication regarding the 10/611,563 application, it is my belief that Ms. Mayers is wrongly refusing to sign the declaration, and to join in the prosecution of the 10/611,563 application, and that her refusal is explicit and unequivocal. Thus, her conduct constitutes refusal sufficient to satisfy the requirements for acceptance of the application under 37 C.F.R. §1.47(a).

22. I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge.

DATED this 28 day of April 2003.



---

Patrice Jacobson  
Senior Legal Manager  
General Counsel's Office  
American Express Travel  
Related Services Company, Inc.



Please note that the below Exhibits are protected by the Attorney Client and Attorney Work Product Privileges and no privilege is waived with respect to the subject matter of the communications. Further, certain portions of the emails presented are redacted to protect the privileges pertaining thereto. In addition, certain exhibits have been re-typed and/or include underlining, where indicated, to facilitate understanding of the communication. In any event, the communications shown below are true reproductions of the Exhibits original content.

**Exhibit A**

Date: July 23, 2001  
From: Patrice Jacobson  
To: Deb Mier  
Subject: Inventors on Pay Fob Applications

**-MESSAGE-**

>>>"Patrice Jacobson"<Patrice.Jacobson@aexp.com> 07/23/01 12:47PM>>>  
Mir-Please note that the following should be added:

[REDACTED]

Deb - Please provide the names of the inventors for Pay Fob. Thanks, Patrice

CC: Sobelman, Howard

**-NEW MESSAGE-**

From: Deborah Mier  
To: "Miriam.A.Galarza@aexp.com".GWIA3.EXTERN2;  
"Patrice.Jacobson@aexp.com".GWIA3.EXTERN2  
Date: 7/23/01 1:17PM  
Subject: Re: Round 4 Patent Awards

The inventors for Pay Fob (aka Roadrunner) are:

John R. Williamson  
Alexandra Mayers  
David S. Bonalle  
Jennifer Anne Elwood  
Peter D. Saunders  
Michael J. Berardi  
Kathryn D. Scheduling  
Matthew C. Hood

Susan E. Isenberg  
Sejal Ajit Shah

Deb

## Exhibit B

From: "Mier, Deborah" <dmier@swlaw.com> on 07/17/2002 09:57 AM  
To: Patrice Jacobson@AMEX  
cc: "Sobelman, Howard" <hsobelman@swlaw.com>, "Mixon, Patrick"  
<pmixon@swlaw.com>  
Subject: RE: TOTALLY CONFUSED

Patrice,  
I apologize for the typo in the body of the letter, it should have said we filed a Provisional patent application (not Utility). Patrick Mixon filed a Provisional relating to PayFob yesterday (40655.9450).

We will be filing a PayFob CIP which will claim priority to the 40655.9450 Provisional and the PayFob Appl. 40655.7000. That CIP application will be our matter number 50655.0800.

So, we need AMEX Matter numbers for 40655.9450 and 50655.0800. Thanks. Deb

**Exhibit C**  
**(Assignment Document)**

## ASSIGNMENT

## UTILITY PATENT

WHEREAS, the undersigned inventor(s) (hereinafter singly and collectively, "ASSIGNOR") of the addresses indicated below, have invented subject matter disclosed in the provisional application for Letters Patent of the United States entitled SYSTEM AND METHOD FOR RFID PAYMENTS filed on July 10, 2001 and assigned U.S. Serial No. 60/304,216;

AND WHEREAS, AMERICAN EXPRESS TRAVEL RELATED SERVICES COMPANY, INC. (hereinafter "ASSIGNEE"), a corporation organized and existing under and by virtue of the laws of the State of New York having its principal place of business and mailing address at General Counsel's Office, American Express Tower, World Financial Center, New York, New York 10285-4900, is desirous of memorializing its interest therein;

NOW, THEREFORE, the undersigned ASSIGNOR hereby confirms that ASSIGNOR is a full time salaried employee of ASSIGNEE and that ASSIGNOR developed the subject matter of the invention on ASSIGNEE's time and at the expense of ASSIGNEE and within the scope of ASSIGNOR's duties as an employee of ASSIGNEE and thereby ASSIGNOR recognizes that the ASSIGNEE owns the invention as described in the aforesaid application. Nonetheless to comport with Patent Office procedures, ASSIGNOR memorializes that relationship in the form of this assignment and;

THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, ASSIGNOR by these presents does sell, assign and transfer unto ASSIGNEE, its successors, assigns and legal representatives, the full and exclusive right to the invention, as described in the aforesaid application, including patent, copyright and any other intellectual property rights, any provisional, non-provisional, continuation, continuation in part, divisional, reissue, reexamination, foreign, PCT or other patent application or like document, or any other application which claims priority to said application, in the United States and all foreign countries, together with the right of priority under the International Convention for the Protection of Industrial Property, Inter-American Convention Relating to Patents, Designs and Industrial Models, and any other international agreements to which the United States adheres, and hereby authorizes and requests the Commissioner of Patents to issue said Letters Patent to ASSIGNEE, for the sole use and benefit of ASSIGNEE, its successors, assigns and legal representatives,

AND HEREBY AGREES to transfer to ASSIGNEE, its successors, assigns and legal representatives, without further remuneration, a like interest in and to any improvements, derivative works, and applications based thereon, growing out of or relating to the invention; and to provide all reasonable assistance and execute any papers, if accurate, desired by ASSIGNEE, its successors, assigns and legal representatives, to preserve, acquire and/or perfect ASSIGNEE's full protection and title

in and to the invention and any improvements and to file any of the aforementioned applications.

In the event that the Application Number and/or filing date is not available when this Assignment is executed, I hereby authorize and request any attorney associated with Snell & Wilmer L.L.P., Customer No. 20322, to insert above the filing date and/or the application number of said application when known.

EXECUTED as of the date(s) written below by ASSIGNOR:

INVENTOR'S NAME

ADDRESS

SIGNATURE

DATE

John R. Williamson

302 PAVONIA AVE  
Jersey City, NJ  
07302

[Signature]

10/9/01

Alexandra Mayers

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

[Signature]

10/9/01

David S. Bonalle

77 Rose Hill Ave  
New Rochelle, NY  
10804

[Signature]

10/9/01

Jennifer A. Elwood

115 E. 34<sup>th</sup> St.  
Apt. # 8G  
New York, NY 10016

[Signature]

10/08/01

Peter D. Saunders

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Michael J. Berardi

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\_\_\_\_\_  
\_\_\_\_\_

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\_\_\_\_\_

Kathryn D. Scheduling

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\_\_\_\_\_

in and to the invention and any improvements and to file any of the aforementioned applications.

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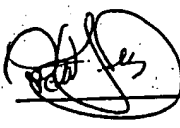
EXECUTED as of the date(s) written below by ASSIGNOR:

INVENTOR'S NAME	ADDRESS	SIGNATURE	DATE
<u>John R. Williamson</u>	_____ _____ _____	_____	_____
<u>Alexandra Mayers</u>	<u>19 Grove St</u> <u>Apt 5B</u> <u>New York NY 10014</u>	<u>Alexandra Mayers</u>	<u>11/1/01</u>
<u>David S. Bonalle</u>	_____ _____ _____	_____	_____
<u>Jennifer A. Elwood</u>	_____ _____ _____	_____	_____
<u>Peter D. Saunders</u>	_____ _____ _____	_____	_____
<u>Michael J. Berardi</u>	_____ _____ _____	_____	_____
<u>Kathryn D. Scheduling</u>	_____ _____ _____	_____	_____

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EXECUTED as of the date(s) written below by ASSIGNOR:

INVENTOR'S NAME	ADDRESS	SIGNATURE	DATE
<u>John R. Williamson</u>	_____ _____ _____	_____	_____
<u>Alexandra Mayers</u>	_____ _____ _____	_____	_____
<u>David S. Bonalle</u>	_____ _____ _____	_____	_____
<u>Jennifer A. Elwood</u>	_____ _____ _____	_____	_____
<u>Peter D. Saunders</u>	<u>3710 East Palisade Dr</u> <u>Salt Lake City</u> <u>UT 84109</u>		<u>11/2/01</u>
<u>Michael J. Berardi</u>	_____ _____ _____	_____	_____
<u>Kathryn D. Scheduling</u>	_____ _____ _____	_____	_____

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In the event that the Application Number and/or filing date is not available when this Assignment is executed, I hereby authorize and request any attorney associated with Snell & Wilmer L.L.P., Customer No. 20322, to insert above the filing date and/or the application number of said application when known.

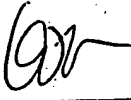
EXECUTED as of the date(s) written below by ASSIGNOR:

INVENTOR'S NAME	ADDRESS	SIGNATURE	DATE
<u>John R. Williamson</u>	_____ _____ _____	_____	_____
<u>Alexandra Mayers</u>	_____ _____ _____	_____	_____
<u>David S. Bonalle</u>	_____ _____ _____	_____	_____
<u>Jennifer A. Elwood</u>	_____ _____ _____	_____	_____
<u>Peter D. Saunders</u>	_____ _____ _____	_____	_____
<u>Michael J. Berardi</u>	7770 NW 50 <sup>th</sup> St. #306 Lauderhill, FL 33313 _____	<u>Michael J. Berardi</u>	<u>10/03/01</u>
<u>Kathryn D. Scheduling</u>	_____ _____ _____	_____	_____

in and to the invention and any improvements and to file any of the aforementioned applications.

In the event that the Application Number and/or filing date is not available when this Assignment is executed, I hereby authorize and request any attorney associated with Snell & Wilmer L.L.P., Customer No. 20322, to insert above the filing date and/or the application number of said application when known.

EXECUTED as of the date(s) written below by ASSIGNOR:

INVENTOR'S NAME	ADDRESS	SIGNATURE	DATE
<u>John R. Williamson</u>	_____ _____ _____	_____	_____
<u>Alexandra Mayers</u>	_____ _____ _____	_____	_____
<u>David S. Bonalle</u>	_____ _____ _____	_____	_____
<u>Jennifer A. Elwood</u>	_____ _____ _____	_____	_____
<u>Peter D. Saunders</u>	_____ _____ _____	_____	_____
<u>Michael J. Berardi</u>	_____ _____ _____	_____	_____
<u>Kathryn D. Scheduling</u>	<u>220 E. 54th St #6J</u> <u>NY, NY 10022</u> _____ _____	 _____	<u>11/2/01</u>

Matthew C. Hood

1112 Lafayette Rd  
Wayne, PA 19087

Matthew C. Hood

10/3/2001

Susan E. Isenberg

Sejal Aijt Shah

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Fax (602) 382-6070

Matthew C. Hood

Susan E. Isenberg

Sejal Ajit Shah

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230 East 30th St  
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Susan Isenberg

10/15/01

Sejal Shah

10/09/01

**SNELL & WILMER L.L.P.**  
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Phoenix, Arizona 85004-2202  
(602) 382-6228  
Fax (602) 382-6070

**Exhibit D**  
**(Recordation of Assignment)**

**CERTIFICATE OF MAILING FIRST CLASS MAIL (37 CFR 1.600)**

Applicant(s): Williamson, et al.

Docket No.

40655.7050

Serial No.

60/304,216

Filing Date

July 10, 2001

Examiner

N/A

Group Art Unit

N/A

Invention: SYSTEM AND METHOD FOR RFID PAYMENTS



I hereby certify that this Assignment, Recordation Cover Sheet and accompanying fee  
(Identify type of correspondence)

is being deposited with the United States Postal Service as first class mail in an envelope addressed to: The

Commissioner of Patents and Trademarks, Washington, D.C. 20231-0001 on November 27, 2001  
(Date)

Deborah A. Mier

(Typed or Printed Name of Person Mailing Correspondence)

(Signature of Person Mailing Correspondence)

Note: Each paper must have its own certificate of mailing.



UNITED STATES  
PATENT AND  
TRADEMARK OFFICE

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MARCH 05, 2002

SNELL & WILMER L.L.P.  
HOWARD I. SOBELMAN  
ONE ARIZONA CENTER  
400 E. VAN BUREN  
PHOENIX, AZ 85004-2202



SNELL & WILMER

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Washington, DC 20231  
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UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 01/07/2002

REEL/FRAME: 012442/0659  
NUMBER OF PAGES: 13

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:  
WILLIAMSON, JOHN R.

DOC DATE: 10/09/2001

ASSIGNOR:  
MAYERS, ALEXANDRA

DOC DATE: 11/01/2001

ASSIGNOR:  
BONALLE, DAVID S.

DOC DATE: 10/09/2001

ASSIGNOR:  
ELWOOD, JENNIFER A.

DOC DATE: 10/08/2001

ASSIGNOR:  
SAUNDERS, PETER D.

DOC DATE: 11/02/2001

ASSIGNOR:  
BERARDI, MICHAEL J.

DOC DATE: 10/03/2001

ASSIGNOR:  
SCHEDING, KATHRYN D.

DOC DATE: 11/02/2001

ASSIGNOR:  
HOOD, MATTHEW C.

DOC DATE: 10/03/2001

ASSIGNOR:  
ISENBERG, SUSAN E.

DOC DATE: 10/15/2001

ASSIGNOR:  
SHAH, SEJAL AJIT

DOC DATE: 10/09/2001

ASSIGNEE:  
AMERICAN EXPRESS TRAVEL RELATED  
SERVICES COMPANY, INC.  
AMERICAN EXPRESS TOWER, WORLD  
FINANCIAL CENTER  
GENERAL COUNSEL'S OFFICE  
NEW YORK, NEW YORK 10285-4900

SERIAL NUMBER: 60304216  
PATENT NUMBER:

FILING DATE: 07/10/2001  
ISSUE DATE:

SHARON BROOKS, EXAMINER  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

## Exhibit E

From: Patrice Jacobson [mailto:patrice.jacobson@aexp.com]  
Sent: Monday, October 28, 2002 8:52 AM  
To: Alexandra Mayers  
Subject: Re: PayFob Documents - URGENT 2nd REQUEST!!!!!!!!!!

Lexy - Thanks for the response. As I understand your concern I doubt that there will be any language included in your agreement that would prohibit you from executing the Assignment and Declaration documents as this work was done while you were an employee of Amex. Please note that it is imperative that these documents are executed by you as soon as possible since you are the remaining inventor that still needs to execute these documents. If you have any questions or want me to take a look at anything then please feel free to call me at 212-640-5879. Thanks, Patrice

(Underline Emphasis Added)

## Exhibit F

-----Original Message-----

**From:** Mixon, Patrick  
**Sent:** Monday, July 08, 2002 2:44 PM  
**To:** 'jeff.s.fehlhaber@aexp.com'  
**Cc:** 'tracey.r.thomas@aexp.com'  
**Subject:** Attorney Client Privilege  
Jeff:

Please decrypt the above document and forward to Tracey Thomas.

Kindest regards.

Tracey:

attached is the application and drawings for the Utility PayFob (40655.7000). I believe Susan Isenberg has reviewed the final draft of the Utility Application.

Also attached is a draft of the provisional. Please keep in mind that the Provisional (40655.9450) will undergo at least one more iteration before we file. Peter Saunders is reviewing the provisional application and will provide comments.

Let me know if you have any questions or concerns.

Kindest regards,

Patrick

(Underline Emphasis Added)

-NEW MESSAGE-

-----Original Message-----

**From:** Mixon, Patrick  
**Sent:** Monday, July 08, 2002 3:13 PM  
**To:** 'jeff.s.fehlhaber@aexp.com'  
**Subject:** Attorney Client Privilege  
Jeff:

attached are Assignment and Declaration Documents for 40655.7000 and 40655.9450.

Patrick

(Underline Emphasis Added)

-NEW MESSAGE-

-----Original Message-----

From: Mixon, Patrick  
Sent: Wednesday, August 21, 2002 11:31 AM  
To: 'Coby S Royer'; Patrice Jacobson  
Subject: RE: FW: Roadrunner INVENTOR DETAILS

Patrice/Coby:

For 40655.7000 (PayFob Application), we forwarded the assignment and inventor declaration documents to Jeff Felhaber on July 8, 2002. As of yet, the executed documents have not been returned to our office.

We filed the PayFob application without the executed documents. As expected, we have received a "Notice to File Missing Parts" wherein the PTO is requested the executed inventor declaration be returned to the PTO by October 7, 2002 in order for us to keep our filing date.

For your convenience, I have re-attached the assignment and declaration documents to this email.

For 40655.9450 (PayFob Provisional CIP) I have attached the assignment and inventor declaration documents to be executed. Please note that all the inventor information is complete except the information for Trevor W. Perry and Kristin VonWald. The address for those inventors will need to be inserted into the form.

The inventor's declaration and assignment may be returned to our office once they have been executed.

Should you have any other questions or need any additional information, please do not hesitate to give me a call.

Kindest regards.

Patrick

-NEW MESSAGE-

-----Original Message-----

From: Mixon, Patrick  
Sent: Friday, September 13, 2002 3:35 PM  
To: Jeff S Fehlhaber; sherry.lane@aexp.com  
Cc: Tracey R Thomas; 'Doug Jelden'  
Subject: FW: FW: Roadrunner INVENTOR DETAILS

Doug:

Per your request, I am resending the Assignment and Declaration Documents for both the PayFob Utility (40655.7000) and the CIP Provisional (40655.9450) for the PayFob.

As we discussed, the declaration document is not typically filed in a "provisional application." However, we are submitting the declaration document for signatures per Susan's request, to address her concerns that some of the inventors may not be available at the time of the CIP Utility (50655.0800) Filing.

Should you have any questions, please do not hesitate to give me a call.

Kindest regards.

Patrick

(Underline Emphasis Added)

## Exhibit G

-----Original Message-----

From: Sherry Lane [mailto:sherry.lane@aexp.com]

Sent: Wednesday, October 16, 2002 4:19 PM

To: Michael J Berardi; Michal H Bliman; David S Bonalle; Jennifer A Elwood; Matthew Hood; Susan Isenberg; Trevor W Perry; Peter D Saunders; Kristin L VonWald; John R Williamson

Cc: Mier, Deborah

Subject: PayFob Documents - 40655.9450 and 40655.7000 URGENT!!!!

Importance: High

Sherry has recieved the following documents from the following people and will forward onto Deb Mier:

Michael J Berardi both

Michal Bliman both

Trevor J Perry only one 40655.9450.....need to get  
40655.7000???????

Peter D Saunders both

Kristin L VonWald only one 40655.9450 need to recieve 40655-7000

HAVE NOT YET RECIEVED EITHER DOCUMENT /ASSIGNMENTS FROM THE  
FOLLOWING FOLKS: (docs below)

David S Bonalle, Jennifer Anne Elwood, Matthew C Hood, Susan E Isenberg, Alexandra Mayers, Kathryn D Scheiding, Sejal Ajit Shah, John R Williamson

Send to:

(inter office or Airborne to)

Attn: Sherry Lane (Mail Code AZ 75-02-01)

2401 W. Behrend Dr., Suite55

Phoenix AZ 85027

602.537.2650

-NEW MESSAGE-

-----Original Message-----

From: Mier, Deborah

Sent: Thursday, October 17, 2002 6:32 AM

To: 'Sherry Lane'

Cc: Michael J Berardi; Michal H Bliman; David S Bonalle; Susan Isenberg; Jennifer A Elwood; John R Williamson; Matthew Hood; Kristin L VonWald; Peter D Saunders; Trevor W Perry

Subject: UPDATE RE: PayFob Documents - 40655.9450 and 40655.7000 URGENT!!!!  
Importance: High

All,

Please note that we are only awaiting signed inventorship documents for 40655.7000 and 40655.9450 from:

Alexandra Mayers  
Kathryn D. Scheduling  
Sejal Ajit Shah

I note that these inventors were not copied on this email. We would greatly appreciate assistance in obtaining their signatures on the Declarations and Assignments, which were attached to Sherry's email. Please ask them to return their executed documents via facsimile to Snell & Wilmer, Attn: Debbie Mier (602) 382-6070 and to please mail the originals to me at the address below.

Thank you all for your attention and assistance in this matter.  
Debbie

**Exhibit H**

From: Susan Isenberg on 10/24/2002 12:54 PM  
To: Patrice Jacobson@AMEX  
cc:  
Subject: Re: Attorney - Client Privilege (40655.7000 and 40655.9450)  
(Document link: Database 'Patrice Jacobson', View '(\$Inbox)')

Patrice,

Do we have all signatures now? What about the non-Amex employees?

Just let me know when you get a minute..

Sue

**-NEW MESSAGE-**

-----Original Message-----

From: Patrice Jacobson [mailto:patrice.jacobson@aexp.com]  
Sent: Thursday, October 24, 2002 12:59 PM  
To: Mier, Deborah  
Cc: Susan Isenberg  
Subject: Re: Attorney - Client Privilege (40655.7000 and 40655.9450)

Deb - Do you have everyone's? Did you receive Lexy Mayer's? Please advise and thanks. PJ

Thanks again Susan for all your assistance!

**-NEW MESSAGE-**

-----Original Message-----

From: Mier, Deborah  
Sent: Friday, October 25, 2002 1:43 PM  
To: 'Patrice Jacobson'  
Cc: Susan Isenberg; Sobelman, Howard; Mixon, Patrick; Tracey R Thomas  
Subject: RE: Attorney - Client Privilege (40655.7000 and 40655.9450)

Hi Patrice,

No, we have not received signed documents from Lexy Mayers. We have originals from all of the other inventors. Thanks for your assistance in pursuing Lexy.

## Exhibit I

From: Patrice Jacobson on 10/26/2002 02:12 PM

To: lexy@aya.yale.edu

cc:

Subject: PayFob Documents - URGENT 2nd REQUEST!!!!!!!!!!

(Embedded

image moved (Embedded image moved to file: pic13452.pcx)

to file:

pic21416.pcx)

Lexy - It was a pleasure speaking with you and it was Jennifer Elwood who provided me with your phone number. As per our conversation please find the four (4) documents that you need to execute below. Please send the originally executed documents via overnight mail to Deb Mier's attention at the address below. Please feel free to call me at 212-640-5879 should you have any questions or want to chat. Again best of luck with all of your endeavors.

Best regards and thank you so much for your assistance with this matter.

Patrice

Deborah A. Mier  
Snell & Wilmer L.L.P.  
One Arizona Center  
400 E. Van Buren  
Phoenix, AZ 85004-2202  
Phone: (602) 382-6123

Please send the documents via Federal Express and Snell & Wilmer's account number is: 085006711

Documents for the original PayFob utility filing:

(See attached file: 40655-7000 Assignment.doc)

(See attached file: 40655-7000 Declaration.doc)

Documents for the provisional PayFob filing:

(See attached file: Assignment-40655.9450.doc)

(See attached file: Declaration-40655.9450.doc)

**Exhibit J**

From: "Alexandra Mayers" <mayerslexy@yahoo.com> on 10/28/2002 12:36 AM

Please respond to "Alexandra Mayers" <lexy@aya.yale.edu>

To: Patrice Jacobson@AMEX

cc:

Subject: Re: PayFob Documents - URGENT 2nd REQUEST!!!!!!!!!!

Patrice,

I'm sorry it has taken me awhile to get back to you. I have been advised that I should probably look over all the original agreements pertaining to my employment before signing an assignment of rights. I'm in the process of getting a hold of those documents from HR, and as soon as I do I will get back to you. My apologies again, and thanks for your patience. Best, Lexy

## Exhibit K

From: Patrice Jacobson on 10/28/2002 10:52 AM

To: "Alexandra Mayers" <lexy@aya.yale.edu>

cc:

Subject: Re: PayFob Documents - URGENT 2nd REQUEST!!!!!!!!!! (Document link: Database 'Patrice Jacobson', View '(\$All)')

Lexy - Thanks for the response. As I understand your concern I doubt that there will be any language included in your agreement that would prohibit you from executing the Assignment and Declaration documents as this work was done while you were an employee of Amex. Please note that it is imperative that these documents are executed by you as soon as possible since you are the remaining inventor that still needs to execute these documents. If you have any questions or want me to take a look at anything then please feel free to call me at 212-640-5879. Thanks, Patrice

## Exhibit L

----- Original Message -----

From: Patrice Jacobson

To: lexy@aya.yale.edu

Cc: Tracey R Thomas ; pmixon@swlaw.com ; dmier@swlaw.com ;  
hsobelman@swlaw.com

Sent: Wednesday, January 15, 2003 10:38 AM

Subject: PayFob Documents - URGENT 3RD REQUEST!!!!!!!!!!

Lexy - Hi and hope you are well. I am still waiting to hear from you regarding the execution of the below documents. Please let me know if you were able to address your concerns or issues regarding your execution of these documents. As previously stated it is critical that you, as an inventor, execute the attached documents. Please respond to me as soon as possible preferably this week.

Thanks and best regards, Patrice

**Exhibit M**

From: "Alexandra Mayers" <mayerslexy@yahoo.com> on 01/15/2003 06:52 PM

Please respond to "Alexandra Mayers" <lexy@aya.yale.edu>

To: Patrice Jacobson@AMEX

cc:

Subject: Re: PayFob Documents - URGENT 3RD REQUEST!!!!!!!!!!

Patrice,

I spoke with an attorney, and he pointed out that contract that you sent states that I assigned these rights for consideration. Since I haven't received any consideration, I don't believe I should execute the contract. Thanks very much Lexy

## Exhibit N

-----Original Message-----

From: Patrice Jacobson [mailto:patrice.jacobson@aexp.com]

Sent: Tuesday, April 22, 2003 6:29 PM

To: lexy@aya.yale.edu

Cc: Mixon, Patrick; Tracey R Thomas

Subject: Declaration and Assignment Documents for 50655.0900

Importance: High

Lexy - Please find attached documents relating to the PayFob matter. Please execute and return to Patrick Mixon's attention at Snell & Wilmer's address below. Thanks very much.

Regards, Patrice

## Exhibit O

----- Original Message -----

From: Patrice Jacobson

To: lexy@aya.yale.edu

Cc: pmixon@swlaw.com ; Tracey R Thomas

Sent: Wednesday, April 23, 2003 9:44 AM

Subject: Declaration and Assignment Documents for 40655.9400

Lexy - Please find attached documents relating to the PayFob matter. Please execute and return to Patrick Mixon's attention at Snell & Wilmer's address below. Thanks very much.

Regards, Patrice

### -New Message-

From: "Alexandra Mayers" <mayerslexy@yahoo.com> on 04/23/2003 10:50 AM

Please respond to "Alexandra Mayers" <lexy@aya.yale.edu>

To: Patrice Jacobson@AMEX

cc:

Subject: Re: Declaration and Assignment Documents for 40655.9400

Dear Patrice,

As far as I understand, this is the form you have sent me before. As we discussed, on the advice of my attorney I have no plans to sign the document assigning my rights without consideration.

Sincerely,

Lexy

## **Exhibit P**

U.S. Petition Office Decision GRANTING the 37 C.F.R. § 1.47(a) Petition to  
Accept the Application for the 10/192,488 application.

## **Exhibit Q**

U.S. Petition Office Decision GRANTING the 37 C.F.R. § 1.47(a) Petition to  
Accept the Application for the 10/340,352 application.

## **Exhibit R**

U.S. Petition Office Decision GRANTING the 37 C.F.R. § 1.47(a) Petition to  
Accept the Application for the 10/318,480 application.

**EXHIBIT D**

**to**

**PETITION FOR ACCEPTANCE OF APPLICATION  
PURSUANT TO 37 C.F.R. §1.47  
INVENTOR REFUSES TO SIGN**



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

Alexandria Mayers  
19 Grove Street  
New York, NY 10014

In re Application of:  
Berardi et al.  
Application No. 10/340,352  
Filed: January 10, 2003  
Title of Invention: SYSTEM AND  
METHOD FOR INCENTING PAYMENT  
USING RADIO FREQUENCY  
IDENTIFICATION IN  
CONTACT AND CONTACTLESS  
TRANSACTIONS

**COPY MAILED**

**JUL 14 2003**

**OFFICE OF PETITIONS**


LETTER

Dear Ms. Mayers:

You are named as a joint inventor in the above-identified United States patent application filed under the provisions of 35 U.S.C. 116 (United States Code) and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at (703) 305-0014. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

  
Derek L. Woods  
Petitions Attorney  
Office of Petitions

cc: SNELL & WILMER L.L.P.  
One Arizona Center  
East Van Buren  
Phoenix, AZ 85004-2202



UNITED STATES PATENT AND TRADEMARK OFFICE

40655.9400

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

*P. Mixon*  
SNELL & WILMER L.L.P.  
One Arizona Center  
East Van Buren  
Phoenix, AZ 85004-2202

Paper No. 8

**COPY MAILED**

JUL 14 2003

**OFFICE OF PETITIONS**

In re Application of:  
Berardi et al.  
Application No. 10/340,352  
Filed: January 10, 2003  
Title of Invention: SYSTEM AND  
METHOD FOR INCENTING PAYMENT USING  
RADIO FREQUENCY IDENTIFICATION IN  
CONTACT AND CONTACTLESS  
TRANSACTIONS

DECISION GRANTING  
STATUS  
UNDER 37 CFR 1.47(a)

This Decision is in response to a Petition Under 37 C.F.R. 1.47(a), filed May 8, 2003 (Certificate of Mailing dated May 5, 2003), to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s).

The petition is granted.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

Petitioner has shown that the non-signing inventor, Alexandra Mayers, refuses to sign the declaration.

As provided in Rule 1.47(a), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the Petition. Notice of the filing of this application will also be published in the Official Gazette.

The application file is being returned to the Office of Initial Patent Examination for continued processing.

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0014.

*Derek L. Woods*  
Derek L. Woods  
Petitions Attorney  
Office of Petitions

**RECEIVED**

JUL 17 2003

**SNELL & WILMER**

NOTED FOR RECEIPT